

Attorney Docket No. 915-011.005
Application Serial No. 10/521,663

In the Drawings:

Please amend Figure 7b per the attached replacement sheet and accompanying annotated marked-up sheet.

REMARKS

In response to the Official Action of September 5, 2006, minor amendment has been made to the specification at page 6 and a slight amendment has been made to Figure 7b as set forth in the attached Replacement Sheet. In addition, claim 12 has been amended in a manner to make the claim in compliance with 35 USC §112, second paragraph. Claim 14 has also been amended to change the spelling of one word. For the reasons set forth below, it is respectfully submitted that all of the claims of the present application are distinguished over the cited art.

More particularly, minor amendment has been made to Figure 7b to conform to the description of this figure to the specification. The amendment to the specification at page 6 corrects a misspelling and makes clear which figure is being referred to. No new matter is added to Figure 7b or the specification.

Referring now to paragraph 1 of the Official Action, claim 14 has been amended to use the American English spelling “molded” rather than the English spelling “moulded”.

Referring now to paragraph 2 of the Official Action, claim 12 has been amended to particularly point out and distinctly claim the invention. Use of the objected to language “the flexible cover substantially made in accordance with the techniques used in the fabrication of sport shoes” has been deleted. This claim is now believed to be definite.

Referring now to paragraph 3 of the Official Action, it is respectfully submitted that claims 1-10, 15, 16 and 20 are not obvious under 35 USC §103(a) in view of US patent application publication 2002/0193136, Halkosaari et al (hereinafter Halkosaari), further in view of US patent application publication 2003/0083094, Hsu et al (hereinafter Hsu). It is asserted by the Office that Halkosaari shows a mobile electronic device providing an engine assembly and a flexible cover overlying, without an intermediate

rigid cover, and snugly fitting the engine assembly and comprising an integrated keyboard, for user input, aligned with the plurality of switches. It is further asserted by the Office that Halkosaari does not explicitly show a leather or fabric flexible cover but that Hsu does teach a cover for a portable mobile phone made of leather or fabric. Applicant's attorney respectfully disagrees with this argument.

More specifically, Halkosaari does not show or describe a flexible cover but rather is directed to a changeable cover or shell which is made of a rigid material. In Halkosaari, the shells of the phone are made of molded polymer plastic shells or from composite materials, metals, or other suitable material (see paragraph 12, lines 4-7 and paragraph 21, lines 3-6). The shell disclosed in Halkosaari is therefore rigid. The shells in Halkosaari must also be rigid in order to enable the key/recess locking system to work as described therein. This is illustrated in Figure 3 of Halkosaari and is further described at column 22, lines 15-21.

Hsu does not make up for these deficiencies. In particular, Hsu discloses a technique to attach a soft material layer (2) to a base resin layer (4) using a plastic film. The base resin layer is poured into a mold formed by the combination of plastic film and soft material (see abstract).

At paragraph 15 of Hsu, it is stated that the base resin layer is made of Acrylonitrile-butadiene-styrene (ABS) resin. Such a resin is a rigid thermal plastic. The combination of soft material, plastic film and a rigid base resin layer form a rigid enclosure for a phone, for example.

Thus, Hsu does not disclose a flexible cover. Rather, the soft material, although possibly flexible, is not used as a cover by itself but is combined to form a rigid enclosure that is used as a cover. If the soft material is considered to be a "flexible cover," then Hsu teaches the use of an intermediate rigid cover which is the base resin layer.

Consequently, neither Halkosaari or Hsu disclose a “flexible cover overlying, without an intermediate rigid cover...the engine assembly”. In fact, no combination of the teaching of Halkosaari and Hsu could produce claim 1 of the present application.

In addition, there is no motivation to combine the teaching of Halkosaari and Hsu as Halkosaari relates to waterproofing a phone (see paragraph 6) and Hsu relates to creating a rigid cover with a “skin”.

In the case of *In Re Sang Su-Lee*, 277 F.3d 1338, 1345-46, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002), the CAFC reiterated that “a showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding.” The mere fact that references can be combined does not render the resultant combination obvious unless there is a “suggestion or motivation in the reference” to combine. *In re Mills*, 916 F.2d 680, 682; 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) cited at MPEP § 2143.01 (emphasis added).

Of course, “an express written motivation to combine” need not appear in prior art references. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276; 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). However, merely finding motivation to combine prior art references in the nature of the problem to be solved, instead of finding that motivation in the express or implied statements of the prior art, is “particularly relevant with simpler mechanical technologies.” *Id.* Moreover, the motivation shown by the examiner must have existed “before the invention itself, to make the new combination.” *Id.* “The factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). This factual inquiry “cannot be dispensed with.” *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Also see, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’”) (quoting *C.R.Bard, Inc., v. M3*

Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617(Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

Furthermore, even if, for purposes of argument, an attempt is made to combine Halkosaari and Hsu, there would be no motivation to remove a rigid cover as disclosed in Halkosaari and replace it with a flexible cover (even if Hsu is considered to be a flexible cover as discussed above). Halkosaari requires the cover to be rigid for its locking mechanism to work and thus to use a flexible cover would teach away from this requirement of Halkosaari. Motivation is negated if the proposed modification of a reference renders the prior art unsatisfactory for its intended purpose (MPEP 2143.01 V). Therefore, there would be no motivation to combine Halkosaari with Hsu even if Hsu was directed to a flexible cover.

For all of the foregoing reasons, it is therefore respectfully submitted that claim 1 is distinguished over Halkosaari and Hsu.

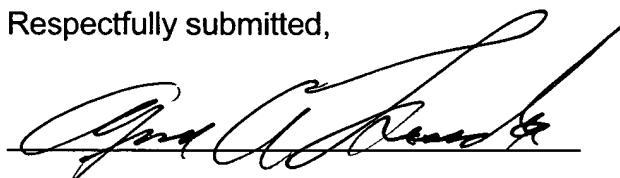
For similar reasons, independent claims 16 and 20, which recite similar limitations as those discussed above with regard to claim 1, are also distinguished over Halkosaari and Hsu. Since independent claims 1, 16 and 20 are believed to be

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distinguished over the cited art, it is respectfully submitted that the dependent claims thereto are further distinguished over the cited art.

For all of the foregoing reasons, it is respectfully submitted that the present application as amended is in condition for allowance and such action is earnestly solicited.

Respectfully submitted,



Alfred A. Fressola
Attorney for Applicant
Registration No. 27,550

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WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
Bradford Green, Building Five
755 Main Street, P.O. Box 224
Monroe, CT 06468
Telephone: (203) 261-1234
Facsimile: (203) 261-5676
USPTO Customer No. 004955

ANNOTATED

MARKED-UP SHEET

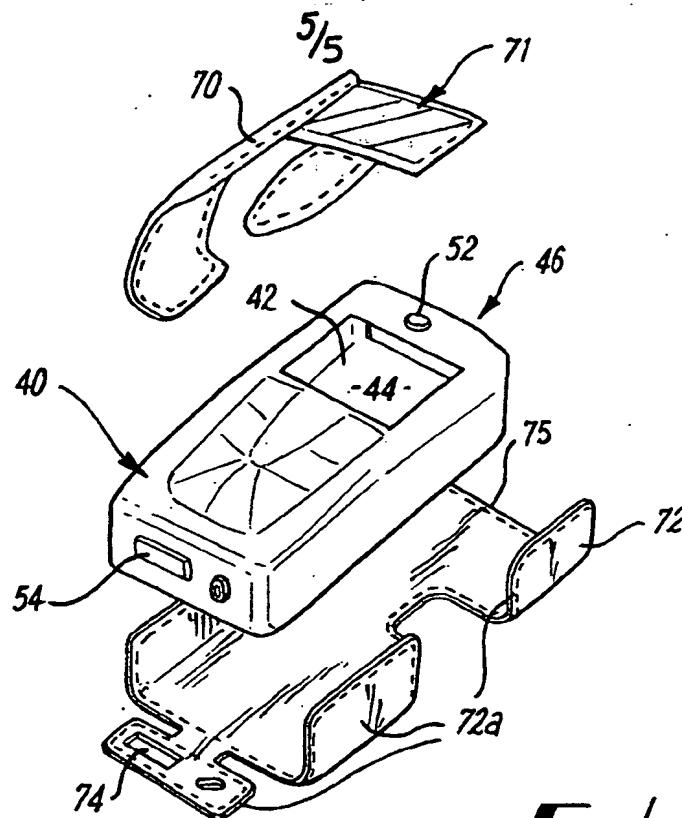


Fig. 7a

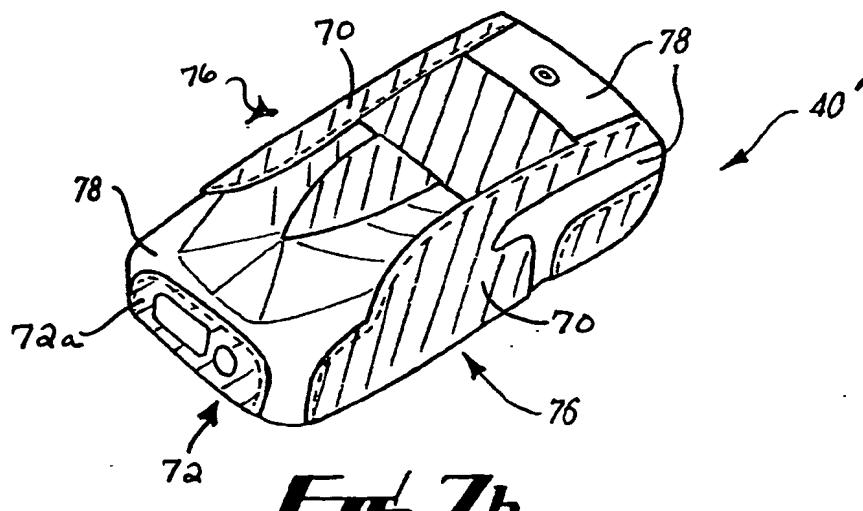


Fig. 7b